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Application Number	10/827,409
Filing Date	April 19, 2004
First Named Inventor	Robert Louis Hodges
Art Unit	2822
Examiner Name	Ida M. Soward
Attorney Docket No.	98-P-104D1 (850063.542D1)

ENCLOSURES (check all that apply)

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	Seed Intellectual Property Law Group PLLC	Customer Number	30423
Signature			
Printed Name	Robert Iannucci		
Date	October 27, 2005	Reg. No.	33,514

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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PATENT & TRADEMARK OFFICE

Applicant	:	Robert Louis Hodges
Application No.	:	10/827,409
Filed	:	April 19, 2004
For	:	SELF-ALIGNED GATE AND METHOD
		Examiner : Ida M. Soward
		Art Unit : 2822
		Docket No. : 98-P-104D1 (850063.542D1)
		Date : October 27, 2005

Mail Stop Amendment
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents:

In response to the Restriction Requirement dated September 28, 2005, the applicant hereby elects **with traverse** Group I, claims 14-19, for examination at this time.

The applicant traverses the Restriction Requirement for three reasons. First, the Examiner incorrectly stated that the inventions of groups I and II are related as process of making and product made. Claims 1-13 of Group II are not directed to a process of making and are instead directed to a product made. In particular, claims 1-13 are product by process claims.¹ As stated in MPEP § 806.05(f), “a product defined by the process by which it is made is still a **product claim** (*In re Bridgeford*, 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process” As such, MPEP § 806.05(f) enables product by process claims to be restricted from process claims and not from other product claims.

Second, even if the claims of Group II were process claims, the Examiner has not correctly shown that the product claims of Group I could be made by a materially different process. In particular, the Examiner incorrectly states that performing the source and drain regions before depositing the gate electrode is a materially different process from the steps of the Group II invention. The claims of Group II do not require that the source and drain regions are

¹ Note that the claims of parent application 09/170,957 were subjected to a Restriction Requirement dated May 6, 2002. In that Restriction Requirement, claim 11 was identified by the Examiner as a product claim and was classified in class 257, subclass 327 in order to restrict claim 11 from the method claims of the parent application. It seems inconsistent and unfair to now label claim 11 as a process claim to restrict claim 11 from other product claims.

formed after depositing the gate electrode. For example, although claim 1 shows the step of forming source and drain regions in a position below the step of depositing a gate electrode, nothing in the language of those steps or any other steps of claim 1 requires the depositing step to be performed first. It has been long established that the order of performing the steps of a method should not be presumed from the order in which the steps are written. *Interactive Gift Express, Inc. v. Compuserve Inc.*, 256 F.3d 1323, 1342-43, 59 USPQ2d 1401 (Fed. Cir. 2001). Accordingly, the Examiner has not established a process of making the product of Group I that is materially different from the steps recited in the product by process claims of Group II.

Third, the claims of Group II were incorrectly classified in a class and subclass that is different from the class and subclass of the claims of Group I. In particular, the Examiner incorrectly classified the claims of Group II in class 438, subclass 223. Class 438 is directed to "SEMICONDUCTOR DEVICE MANUFACTURING: PROCESS." As discussed above, the claims of Group II are product claims, not process claims, and thus should not be classified in process class 438. Instead, the claims of Groups I and II should be classified in the same product class.²

For the foregoing reasons, the applicant respectfully requests withdrawal of the restriction requirement.

Consideration of the elected claims is now requested.

Respectfully submitted,
Seed Intellectual Property Law Group PLLC



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² The applicant also submits that claims 14-19 were incorrectly classified in class 257, subclass 371, which is directed to "complementary transistors." Claims 14-19 do not recite complementary transistors, which are a pair of transistors of opposite type, such as PMOS and NMOS transistors.